

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 16-19 are pending in this application. Claims 16-18 are amended by the present amendment. As amended Claims 16-18 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Official Action, Claim 16 was rejected under 35 U.S.C. §101; Claims 16-19 were rejected under the judicially created doctrine of obviousness type double patenting in view of U.S. Patent Application Nos. 10/800,681, 10/800,626, 10/800,766, 10/800,764 in view of Okada et al. (U.S. Patent No. 6,181,870), 10/800,755, and 10/800,683 in view of Okada et al. (U.S. Patent No. 6,181,870); Claims 16-19 were rejected under 35 U.S.C. §102(b) as anticipated by Kim et al. (U.S. Patent No. 6,301,587, hereinafter Kim).

As for the rejection of Claim 16 under 35 U.S.C. §101, that rejection is respectfully traversed. Claim 16 is amended to recite that the information recording/reproducing apparatus accesses the control information area to reproduce the still picture video object. Accordingly, it is respectfully requested that this rejection be withdrawn.

MPEP §2106 discusses statutory subject matter in relation to data structures of a computer readable medium. Particularly, MPEP §2106 provides,

a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Thus, based on the clear language of this section, Claim 16 is statutory as it defines a functionality of which is realized based on the interrelationship of the structure to the medium and recited hardware components.

¹See, e.g. the specification at page 81, line 25 to page 82, line 4 and Figures 31-34.

Further, should the Examiner disagree with the above passage, MPEP §2106 also states that,

Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Applicants respectfully submit, as noted above, that the rejection under 35 U.S.C. §101 should be withdrawn. However, if the rejection under U.S.C. §101 is to be maintained, applicants respectfully request that the Examiner provide an explanation of the rejection in view of the guidelines of MPEP §2106.

With regard to the non-statutory double patenting rejection of Claims 16-19 in view of U.S. Patent Application Nos. 10/800,681, 10/800,626, 10/800,766, 10/800,764 in view of Okada et al. (U.S. Patent No. 6,181,870), 10/800,755, and 10/800,683 in view of Okada et al. (U.S. Patent No. 6,181,870), the rejection is respectfully traversed in light of the terminal disclaimer submitted herewith.

The filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. The "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection.

With regard to the rejection of Claims 16-19 under 35 U.S.C. §102(b) as anticipated by Kim, that rejection is respectfully traversed.

Amended Claim 16 recites in part, "said sub-picture stream is configured to include bitmap data."

In contrast, Kim describes a method for creating and managing navigation information in a recording medium. Kim does not describe that any of the described items recorded on the medium include bitmap data. Although the outstanding Office Action does not cite any portion of Kim as “a sub-picture stream,” it is believed that the description of a text stream (such as IT_TXT managed by TXT_DT_MG)² in Kim is the element being cited as “a sub-picture stream.” However, the text stream of Kim includes, for example, ASCII codes, not bitmap data. Accordingly, it is respectfully submitted that Kim does not teach “said sub-picture stream is configured to include bitmap data,” as recited in Claim 16. Accordingly, Claim 16 (and Claim 19 dependent therefrom) is not anticipated by Kim and is patentable thereover.

Independent Claims 17 and 18 recite similar elements to Claim 16. Consequently, Claims 17 and 18 are believed to be patentable over Kim for at least the reasons described above with respect to Claim 16.

Accordingly, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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²See Kim, Figure 1.